

PATENT
103095-41585

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of:
Rosen et al.

: Art Unit : 1711

Serial No. : 10/661,268

: Examiner : S. Witherspoon

Filed : September 12, 2003

Title : NOVEL MONOFUNCTIONAL
POLYETHYLENE GLYCOL ALDEHYDES:

Code 2814 twice
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not

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**Terminal Disclaimer To Obviate A Double Patenting
Rejection Over A Pending Second Application Serial Number 10/715,607**

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Sun Bio, Inc., a corporation having a principal place of business at 57 Claremont Avenue, Orinda, California 94563, the owner of 100% interest in the instant application, Serial Number 10/661,268, filed September 12, 2003, as assignee of the entire right, title and interest in and to the said application and in and to any and all Letters Patent of the United States which may issue from said application, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 10/715,607, filed November 18, 2003, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Fee Only

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted

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PAGE 9/10 * RCVD AT 3/7/2005 4:01:00 PM [Eastern Standard Time] * SVR:USPTO-EFAXF-1/29 * DNIS:2730849 * CSID:Gibbons Del Deo * DURATION (mm-ss):04-00

on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.
2. ☒ The undersigned is an attorney or agent of record.

 
Signature Date
William H. Epstein
Registration No. : 20,008

- ☒ Terminal Disclaimer Fee under 37 CFR 1.20(d) included.

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POLYETHYLENE GLYCOL ALDEHYDES:Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**RESPONSE AND TERMINAL DISCLAIMERS**

Dear Sir:

This paper is being filed in response to my telephone conversation with the Examiner on March 7, 2005.

At the outset, Applicants Attorney wishes to thank the Examiner for the telephone conversation of March 7, 2005. During said telephone conversation the Examiner requested that Terminal Disclaimers be filed in this Application with respect to Serial Number 10/431,294 and Serial Number 10/715,607. The Examiner indicated that with these Terminal Disclaimers, Claims 60-63 will be allowed.

As discussed during this telephone conversation, Claims 60-63 constitute the elected invention in this Application. Therefore, the Examiner is authorized, if he considers Claims 60-63 to be a separate invention, to cancel all other claims in this Application.

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Correspondence and Fees

Please charge Deposit Account Number 03-3839 in the amount of One Hundred Thirty Dollars (\$130.00) for payment of the Terminal Disclaimer Fee under 37 C.F.R. §1.20(d). No additional fees are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account no. 03-3839 for any underpayment, or to credit any overpayments.

Please address all correspondence to the correspondent address for **Customer No. 26345**. Telephone calls should be made to William H. Epstein at (973) 596-4607 and facsimile communications should be sent directly to him at 973-639-6397.

Respectfully submitted,



William H. Epstein
Attorney for Applicant(s)
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Alexandria, Virginia 22313-1450

**Terminal Disclaimer To Obviate A Double Patenting
Rejection Over A Pending Second Application Serial Number 10/431,294**

Sun Bio, Inc., a corporation having a principal place of business at 57 Claremont Avenue, Orinda, California 94563, the owner of 100% interest in the instant application Serial Number 10/661,268, filed September 12, 2003, as assignee of the entire right, title and interest in and to the said application and in and to any and all Letters Patent of the United States which may issue from said application, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 10/431,294, filed May 7, 2003, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of

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the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer filed prior to its grant.

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Signature

Date

William H. Epstein

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☒ Terminal Disclaimer Fee under 37 CFR 1.20(d) included.

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